

D2 24. (Amended) The method of claim 21 in which (f) includes replacing display of the television programming with display of said page of supplementary data.

REMARKS

Claims 6-7, 11-16, 21-22, 24-28, and 30-34 are pending in the application.

Claims 6-7, 11-16, 21-22, 24-28, and 30-34 have been rejected as being unpatentable in view of the combination of U.S. Patent No. 6,058,430 to Kaplan, U.S. Patent No. 6,169,541 B1 to Smith, and U.S. Patent No. 5,818,935 to Maa. In addition, claims 13-15 and 24 have been rejected under 35 U.S.C. § 112.

Reconsideration of the application is respectfully requested in view of the foregoing amendments and following remarks.

1) **U.S. Patent No. 6,169,541 B1 to Smith is not prior art.**

Applicants submit herewith a Declaration of Prior Invention Under 37 CFR 1.131 by the inventors. This Declaration establishes that the inventors reduced to practice the subject matter of claims 6, 16, 21, and 30 before May 28, 1998.

The effective date of U.S. Patent No. 6,169,541 B1 to Smith as a § 102(e) reference is May 28, 1998. Because the inventors invented the subject matter of claims 6, 16, 21, and 30 before May 28, 1998, U.S. Patent No. 6,169,541 B1 to Smith is not prior art to the application. Applicants respectfully request withdrawal of the final rejection of independent claims 6, 16, 21, and 30, and dependent claims 7, 11-15, 22, 24-28, and 31-34. [See M.P.E.P. 715.02]

The Declaration has been signed by three of the four named inventors. Inventor Christopher White was mailed a copy of the Declaration and accompanying Exhibits on July 17, 2001, but has not yet returned the signed Declaration. [See M.P.E.P. 715.04.] If and when Mr. White returns the signed Declaration, a copy will be submitted to the U.S. P.T.O.

This Declaration is timely submitted with a first reply after a final rejection for the purpose of overcoming a new ground of rejection. [See M.P.E.P. 715.09.]

2) **Claims 13-15 satisfy 35 U.S.C. § 112**

The Office action of February 1, 2001 states that claims 13-15 recite "the limitation 'the control panel.' There is insufficient antecedent basis for this limitation in these claims." [Office

action of February 1, 2001, page 2.] Applicants respectfully disagree. Applicants believe the term “a graphical control panel” of claim 6 provides reasonable antecedent basis for the term “the control panel” recited in each of claims 13-15. [See M.P.E.P 2173.05(e).]

Nevertheless, to expedite prosecution, Applicants amend each of claims 13-15 to recite “graphical control panel” in exact agreement with the language “graphical control panel” recited in claim 6.

The amendments to claims 13-15 address the Examiner’s rejections of these claims under 35 U.S.C. § 112 and thus place claims 13-15 in better condition for appeal. Moreover, as these amendments merely correct informalities in claims 13-15, the amendments should not raise the issue of new matter or present new issues requiring further consideration or search.

3) Claim 24 satisfies 35 U.S.C. § 112

Applicants amend claim 24 to recite “said page of supplementary [image] data” in exact agreement with the language “said page of supplementary data” recited in claim 21.

The amendment to claim 24 places claim 24 in better condition for appeal. Moreover, as the amendment to claim 24 merely correct informalities in claim 24, the amendment should not raise the issue of new matter or present new issues requiring further consideration or search.

The Office action of February 1, 2001 states, “Claim 24 includes a step (f) which is implemented in claim 21. Correction is required.” [Office action of February 1, 2001, page 2.] Applicants respectfully disagree with this characterization of claim 24.


Claim 21 recites, “(f) responsive to said further indication of viewer interest, displaying said page of supplementary data.” Claim 24 as amended recites, “The method of claim 21 in which (f) includes replacing display of the television programming with display of said page of supplementary data.” Claim 24 further limits the act (f) of claim 21. Other ways of carrying out the act (f) of claim 21 are possible. For example, a page of supplementary data can be displayed in picture-in-picture format. [See Application, page 17, lines 23-25.] Thus, Applicants believe that claim 24 as amended satisfies 35 U.S.C. § 112.

CONCLUSION

Claims 6-7, 11-16, 21-22, 24-28, and 30-34 in their present form should be allowable. Such action is respectfully requested.

Respectfully submitted,

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APPENDIX: MARKED-UP VERSION OF AMENDED CLAIMS

13. (Twice amended) The method of claim 6 which includes:
displaying in the graphical control panel a title of the auxiliary data associated with the icon.
14. (Twice amended) The method of claim 13 which includes:
responsive to a second signal from the viewer during the displaying the graphical control panel, displaying the auxiliary data.
15. (Twice amended) The method of claim 13 which includes displaying in the graphical control panel at least one graphical control that can be activated by the viewer to indicate the viewer's desire to view the auxiliary data.
24. (Amended) The method of claim 21 in which (f) includes replacing display of the television programming with display of said page of supplementary [image] data.